

EFW



PATENT
Customer No. 22,852
Attorney Docket No. 06530.0288-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Charles PUGSLEY et al.)	
)	Group Art Unit: 3734
Application No.: 10/706,965)	
)	Examiner: M. Andersen
Filed: November 14, 2003)	
)	
For: TISSUE PATCHES AND)	Confirmation No.: 7789
RELATED DELIVERY SYSTEMS)	
AND METHODS)	

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated March 22, 2006, the Examiner required
restriction under 35 U.S.C. § 121 between:

Group I: Claims 1-3 and 6-24¹, allegedly drawn to a tissue patch; and

Group II: Claims 25-36, allegedly drawn to a method for treating a lesion.

Applicants respectfully traverse this restriction requirement for the following
reasons.

¹ The restriction requirement lists claims 1-24 for alleged Group I. Applicants note that claims 4 and 5 have been canceled by the last Amendment filed on December 28, 2005. Thus, claims 1-3 and 5-24 are pending for alleged Group I.

This restriction requirement was made after a first Office Action on the merits. The first Examiner who issued the first Office Action conducted a full search and examination of all original claims 1-36. After the full search and examination, the first Examiner allowed claims 25-36 and also indicated that claims 5 and 6 contain allowable subject matter. In response to that Office Action, Applicants amended independent claim 1 to incorporate the subject matter of claim 5 to place this application in condition for allowance. The current restriction requirement ignores the allowable status of this application. Although a restriction requirement can be made at any time before a final action, a restriction at this stage is not justified since all of the pending claims have been fully searched, examined, and placed in condition for allowance.

Moreover, Section 803 of the MPEP clearly indicates that, if the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even if they include claims to independent or distinct inventions. In this case, the first Examiner believed that the search and examination of all the claims did not pose a serious burden on the Examiner and thus carried out a full search and examination of all the claims on the merits. The mere facts that this application transferred to a new examiner and could have been subject to a restriction requirement before a first Office Action do not justify requiring a restriction at this stage after all the pending claims have been placed in condition for allowance.

For at least the reasons set forth above, Applicants respectfully request reconsideration and withdrawal of this restriction requirement.


Irrespective of the validity of this restriction requirement, to comply with the formal election requirement, Applicants provisionally elect to prosecute Group I (i.e., claims 1-3 and 6-24) in this case.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 21, 2006

By: 

Leslie I. Bookoff
Reg. No. 38,084